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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 929

RONEL CORPORATION,

Petitioner,

—v.—

ANCHOR LOCK OF FLORIDA, INC., GUSTAV LA VICTOR, S. HOWARD BANASZAK, HERMAN KOBRIN, CHESTER LEVINE,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Ronel Corporation prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit entered in the above-entitled case on December 20, 1963.

Citations to Opinions Below

The memorandum opinion of the Judges of the Fifth Circuit Court of Appeals (R. 268 to 271) is reported in 325 F. 2d 889 and is printed in Appendix B hereto, *infra*, p. 20. The opinion of the District Court (R. 247 to 248), printed in Appendix B hereto, *infra*, p. 24, is reported in 312 F. 2d 207.

Jurisdiction

The judgment of the Circuit Court of Appeals was entered on December 20, 1963, R. 272. The jurisdiction of this Court is invoked under 28 U. S. C. 1254(1).

Questions Presented

1. Whether rights conferred pursuant to a constitutional grant (United States Letters Patent) may be abrogated in a summary judgment proceeding under Rule 56 of the Federal Rules of Civil Procedure where genuine factual issues are raised by supporting affidavits of technical experts, to thereby preclude a trial on the merits.

2. Whether in a patent infringement suit in which the suit patent is entitled to the statutory presumption of validity it is proper to award summary judgment of invalidity where genuine issues as to material facts are raised by conflicting affidavits; and particularly where all of the affidavits of the technical experts raise such issues and support such presumption.

Statute Involved

The statutory provisions involved are Rule 56, Federal Rules of Civil Procedure, 28 U. S. C. A., and the Patent Act of 1952 (Title 35, United States Code). The pertinent sections will be found in Appendix A, *infra*, p. 17.

Statement

This suit was commenced by the plaintiff for infringement of its patent, United States Patent No. 2,974,368, issued on March 14, 1961 in the name of Julius Lidsky for Metal Fastener. Plaintiff is in the business of manufacturing and selling truss plates in accordance with the Lidsky patent under the trade name and style RONEL BARB-GRIP and the defendants are charged with infringement of the Lidsky patent by virtue of their manufacture and sale of their ANCHOR LOCK TRUSS PLATES. Defendants filed an Answer including Counterclaims to the Complaint in which they denied the material allegations of the Complaint and interposed Counterclaims including a Counterclaim for Declaratory Judgment with respect to the validity of the patent in suit.

Defendants filed an Amendment to the Answer (R. 174) adding five prior art defense patents, including Patent No. 649,761 to Saltzkorn et al., which was relied upon as the *sole* prior art reference in support of defendants' Motion for Summary Judgment. Defendants filed an affidavit of James N. Lyles, a patent attorney, as the *sole* affidavit in support of their Motion for Summary Judgment.

Plaintiff opposed defendants' Motion for Summary Judgment based on the affidavits of Harold I. Kaplan, a patent attorney, and Julius Lidsky, the patentee of the suit patent. **The latter affidavit has annexed thereto four (4) affidavits of recognized independent consulting engineers i.e. technical scientific experts, who have examined and analyzed the Saltzkorn et al. patent in its relation to the Lidsky patent and concluded that the Lidsky patent structure would not be obvious in view of the Saltzkorn et al. disclosure and was not anticipated thereby as a technical factual matter.**

On September 28, 1961, the lower Court entered its order (R. 247-248) granting partial summary final judgment without opinion and without findings of fact or conclusions of law other than plaintiff's patent in suit "construes merely an improvement and application of the principle and teachings of that certain patent issued to Emil Saltzkorn and Ludwig Nicolai on May 15, 1900, No. 649,761, Eyelet, to a new use which does not rise to the dignity of invention, but is in fact an application of the original Saltzkorn idea".

An Appeal was taken to the United States Court of Appeals for the Fifth Circuit. The Court in its decision rendered December 20, 1963 (R. 268-271) affirmed the District Court's grant of summary judgment in behalf of defendants, ruling that Lidsky patent No. 2,974,368 was invalid. Thus, the Court in effect held that there was no issue of fact respecting the validity of the Lidsky patent, United States 2,974,368, although *all* the *technical* scientific *affidavits* submitted had found that substantial factual issues were present and that the patent was clearly not anticipated by Saltzkorn et al. after detailed scientific appraisal.

It is noted that the District Court had jurisdiction of the initial patent infringement suit under 28 U. S. C. 1338, 1400, and jurisdiction as to the appeal lies with the Circuit Court of Appeals under 28 U. S. C. 1291.

Summary of Reasons for Granting the Writ

1. This case presents important questions of federal law (summary judgment proceedings in patent infringement litigation) which have never been acted upon or settled by this Court but because of their universal implications in patent litigation should be settled with appropriate guide lines.

2. To the extent determinable by analogy, the Lower Court decision herein conflicts with applicable guide lines set up by the decisions of this Court.

3. This case presents important procedural issues under Rule 56 of the Federal Rule of Civil Procedure affecting substantial substantive rights under a constitutional grant (U. S. Letters Patent).

4. The decision of the Court below is patently a departure from the usual course of judicial proceedings involving summary judgment and calls for this court to exercise its powers of supervision over the Federal Judiciary.

ARGUMENT

The rule of this case as it stands is that a Court is empowered to summarily invalidate a Constitutional grant (U. S. Letters Patent) without a trial on the merits by the simple expediency of ignoring the factual issues raised by the affidavits of technical experts. (It is noted that the usual factual issues of validity and infringement are *not* here involved but a *question of law is presented* in which the propriety of summary judgment of invalidity in a patent infringement suit is in issue.)

It is submitted that where substantial factual issues are raised by affidavits of technical experts (and especially where they are the only affidavits of technical experts in the record) that a Court, as a matter of law, cannot bypass a trial on the merits and summarily invalidate a patent and it is accordingly deemed that this case is ripe for exercise of certiorari jurisdiction. A brief reference to the proceedings below will serve to precisely define the issues presented.

The Invention of the Patent in Suit

The Lidsky suit patent (R. 181-184) is directed to the RONEL BARBGRIP TRUSS PLATE, which comprises a plarality of uniquely formed prongs surrounding an opening defined thereby in the base of the plate, each prong having a pointed extremity, relatively sharp barb-forming junctions, a narrower intermediate section, and lower side edges which include portions which merge smoothly with the circumference of a circle which embraces such opening. The prongs are arcuate in cross section throughout the length thereof to provide increased resistance to buckling when the plate is used for its *primary and intended application of securing together wooden truss members in coplanar relation to form a prefabricated truss support.*

Defendants' Motion for Summary Judgment

Defendants' motion for summary judgment (R. 175) was "on the grounds that there is no genuine issue as to any material fact" and was based solely on the affidavit of James N. Lyles, a patent attorney (R. 176-180) who concludes that the suit patent claim is invalid as completely anticipated by Saltzkorn et al.

An analysis of this document reveals that it intertwines conclusions of law, opinion and fact and more importantly contains *manifest errors of fact* as delineated below.

Independent of any issue of claim interpretation, the Lidsky patent claims call for "side edges including portions merging smoothly with the circumference of said circle". The Lyles affidavit considers this claimed limitation to be met by Saltzkorn et al. disclosure in the follow-

ing manner: "The edges of the strip around the edges of the opening are described in line 68 as smooth". The Lyles affidavit completely misconstrues the structure referred to in the above quoted language of the Lidsky patent claim. In the Lidsky patent, the diverging edges of the prongs below the barb-forming junctions merge smoothly with the periphery of the opening defined in the base plate between the prongs and it is this structure that is claimed in the above quoted language of the patent. In contrast, Saltzkorn et al. discloses short projections a' which are formed between the long projections b and a sharp acute angle is formed between the adjacent intersecting edges of the long projections b and the short projections a'. *Thus, where the suit patent claim calls for prongs having in their lower base regions side edges which include portions merging smoothly with the circumference of the circle, Saltzkorn et al. provides a sharp, acute angle which is virtually precisely the opposite of the patent structure claimed.*

Basis of Plaintiff's Position

Plaintiff opposed defendants' motion based on the affidavits of Harold I. Kaplan (R. 185-192), a patent attorney, and Julius Lidsky (R. 214-219), the inventor and patentee of the suit patent and the founder and president of plaintiff. Annexed to the affidavit of Julius Lidsky are affidavits of independent consulting engineers who have examined and analyzed the Saltzkorn et al. patent in relation to the suit patent and product.

The theory of the cross-motion was that plaintiff is entitled to the statutory presumption of validity as a matter of law and since the Saltzkorn et al. patent relied upon by defendants did not anticipate, plaintiff was entitled to sum-

mary judgment in its favor as a matter of law. However, the sharp conflict in factual views in the affidavits presented was always concealed.

Affidavits by Experts in Behalf of Plaintiff

The affidavit of Julius Lidsky (R. 214-219) is based on personal knowledge and is a factual appraisal by an expert skilled in the art whose very business and livelihood is based on such art.

The affidavit points out the many basic distinctions between the Saltzkorn et al. disclosure and the truss plate of the suit patent and further makes the point of an important technical error that appears in Saltzkorn et al., namely, that the bend lines at the base of the prongs must be straight lines as a bend line cannot be formed in sheet metal around the arc of the circle.

Lidsky states that:

> "I have found, both through technical analysis of the Saltzkorn patent and by the fabrication of models in accordance with the teachings of the patent, that when the long projections are forced into the box material and clenched, the bend lines, as shown at 'd, d' in Fig. 6 of the Saltzkorn patent, must be straight and not circular as referred to in the patent."

The affidavit of John F. Michel (R. 219-224), a Registered Professional Engineer of the State of Florida, is a factual analysis of the similarities and differences that exist between Saltzkorn et al. and the suit patent structure. Mr. Michel who has practiced engineering for over twenty (20) years concludes:

> "I therefore conclude that the two devices differ considerably in intended application, design, fabrication, and

method of use. The apparent general similarity in physical configuration results solely from the fact that both devices are made by cutting holes or slits in a sheet of metal and forcing the metal between the holes or slits into projections more or less perpendicular to the plane of the sheet."

The affidavit of Jocelyn F. B. Shaw (R. 241-244), a Registered Professional Engineer of the States of Florida and New York, after analyzing and reporting on the comparison of the two structures concludes:

"Ronel and Eyelet have basically different purposes. They employ different methods for fastening different materials. The details differ as well as the application. The ideas are different. It does not appear that Ronel could be said to be a copy in any way of Eyelet.". (Eyelet refers to the Saltzkorn et al. structure.)

Similarly the affidavit of the firm of Rader and Associates by its Chief Structural Engineer H. M. Schwartz (R. 233-237) contains a very technical and detailed point by point comparison of the two structures and in purely objective fashion concludes:

"In conclusion, it is conceded that there is a slight outward resemblance in general between this truss connector and the eyelet fastener. However, it is our considered opinion that the similarity ceases beyond that point. They are admittedly both connection members of a sort, but are entirely different from each other in their usage, function, required materials and method of application. Further, they depend upon different physical phenomena for their effectiveness."

The affidavit of Aspee A. Irani (R. 238-240), a Registered Professional Engineer and instructor at the Uni-

versity of Miami, emphasizes the many structural distinctions between the prongs of the two structures and includes illustrative diagrams of the respective prongs (R. 239-240). This affidavit also factually distinguishes the two structures in purpose, application, function, and principle.

Notwithstanding the sharp factual issues raised by the aforenoted affidavits and the detailed appraisal and analysis given to the issues by those "skilled in the art" the Court completely ignored this expert guidance and consequently plaintiff has been deprived of its day in Court.

The Triable Issues of Fact

From the foregoing affidavits it will be seen that there are present a number of issues of material facts to be resolved (but which remain unresolved), including the following:

1. The issue of whether Saltzkorn et al. anticipates the suit patent:
   - A. Is the Saltzkorn et al. patent analogous art?
   - B. Does Saltzkorn et al. disclose:
     - (a) a fastening plate for wooden truss structures;
     - (b) prongs of the character of the Lidsky patent prongs; and
     - (c) prongs having lower side edge portions which merge smoothly with the circumference of the base circle.
   - C. The issues with respect to difference of function, structure, application and principle between the suit patent device and the device of the Saltzkorn et al. patent.

D. Is Saltzkorn et al. operative as disclosed with respect to the bend lines at the base of the prongs?

2. The issue of obviousness of the invention in the light of the history of the development of the art.

3. Does the suit patent rise to the "dignity of invention"? The District Court found that the patent in suit constitutes an improvement over Saltzkorn et al. from which it follows that the latter is not a direct anticipation

The Broader Issues Presented

This Court has never acted upon, nor defined, the propriety of summary judgment in an action involving a Federal grant (in the instant case, a United States patent) where there are conflicting affidavits and expert testimony on the precise point in issue, namely, the validity of a patent in the light of prior art.

Indeed, the broader question is raised as to whether such constitutionally authorized grant having a statutory presumption of validity, can be abrogated without trial on the merits by summary judgment where the precise issue is the subject of conflicting affidavits.

From an even broader viewpoint, the Supreme Court has faced the issue of the propriety of summary judgment as a vehicle for deciding a controversy in relatively few cases, and it is believed that its grant of certiorari in the instant case would do much in providing needed guide lines for the lower courts with respect to the propriety of summary judgment in proceedings involving federal grants.

As set forth by this Court in *Associated Press et al. United States*, 326 U. S. 1, at 5, 65 S. Ct. 1416, at 1418 (1945):

> "Rule 56 should be cautiously invoked to the end that parties may always be afforded a trial where there is a bona fide dispute of facts between them."

That the burden is on the party moving for summary judgment and that all reasonable doubts touching the existence of a genuine issue as to material fact must be resolved against the moving party is well established in the Federal Courts. *Weisser* v. *Mursam Shoe Corporation*, 2 Cir., 127 F. 2d 344 (1942); *Sarnoff* v. *Ciaglia*, 3 Cir., 165 F. 2d 167 (1947).

It is submitted that this burden has not been satisfied in the instant case. The present controversy deals with a patent issued by the United States Patent Office after examination by Patent Office experts under the Constitutional provision authorizing issuance of such grants (Art. 1, Section 8). That United States patents have a statutory presumption of validity is specifically set forth in the patent statute, to wit, 35 U. S. C. Section 282, "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on the party asserting it."

In the instant litigation, the issue presented by the defendants' Motion for Summary Judgment is whether there was an issue of fact as to the inventiveness of the invention claimed in the Lidsky patent No. 2,974,368. More particularly, would truss plates of the patent have been "obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains", 35 U. S. C. Section 103.

The issue having resolved itself to whether the Lidsky patent would have been obvious to one skilled in the art, plaintiff-patentee introduced the aforementioned affidavits of several independent consulting engineers who examined and analyzed the Saltzkorn et al. patent in relation to the

suit patent and product. *All* these experts concluded that the patented structure was *not obvious* in view of this reference.

Accordingly, various technical experts in the very art to which the patent in suit pertains, i.e., "a person having ordinary skill in the art to which the subject matter pertains" (35 U. S. C. § 103) have borne witness to the nonobvious nature of the subject matter of the Lidsky patent.

Thus, the Circuit Court of Appeals in affirming the District Court's granting of summary judgment has held, in effect, that the defendants have satisfied the very heavy burden on them with respect to Rule 56, as well as overcoming the statutory presumption of validity, where the record on its face shows clear and substantial conflict as to the essential issues of novelty and obviousness and, moreover, all affidavits submitted by those who satisfy the statutory standard of "a person having ordinary skill in the art to which the subject matter pertains" have attested to the novelty and nonobvious nature of the Lidsky invention.

The Applicable Case Law

It is submitted that the action of the Circuit Court of Appeals is in conflict with decisions rendered by this Court and the existing guidelines set by case law as well as being an improper extension of the basis for granting summary judgment under the Federal Rules of Civil Procedure, Rule 56, 28 U. S. C. A.

Phrased otherwise, the principle question presented is whether the Lower Court under Rule 56 properly deprived plaintiff of a trial on the merits of its patent infringement action.

The answer depends on whether "there is the slightest doubt about the facts". *Dochler Metal Furniture Company*

v. *United States*, 2 Cir., 149 F. 2d 130, 135 (1945); *Sartor* v. *Arkansas Natural Gas Corporation*, 321 U. S. 620, 622, 64 S. Ct. 724, 726 (1944); *Associated Press et al.* v. *United States*, 326 U. S. 1, 6, 65 S. Ct. 1416, 1418 (1945).

The Supreme Court has not often ruled as to the bounds of propriety in the grant of summary judgment under Rule 56. In the landmark case of *Associated Press* v. *United States*, noted above, the Court stated that "Rule 56 should be cautiously invoked to the end that parties may always be afforded a trial where there is a bona fide dispute of facts between them" (326 U. S. 6, 65 S. Ct. 1418). In the *Associated Press* case, the decision rested on the validity or invalidity of the by-laws and contract of Associated Press. As noted by the Court, "none of the appellants has pointed to any disputed facts essential to a determination of the validity of invalidity of the by-laws and the contract" (326 U. S. 5, 65 S. Ct. 1418). Thus, this Court held that in that action, a summary judgment was proper.

This is directly in contrast with the present case where the cornerstone issue of "obviousness to one skilled in the art" is the subject of conflicting affidavits, and indeed where all technical experts have come to a common and different conclusion than did the Courts below by denying plaintiff a trial on the merits.

In the earlier case of *Sartor* v. *Arkansas Natural Gas Corporation*, 321 U. S. 620, 622, 64 S. Ct. 724, 726 (1944), the Court granted certiorari recognizing that the "importance of questions raised under the summary judgment rule led us to grant certiorari". This Court stated that Rule 56 "authorizes summary judgment *only* where the moving party is entitled to a judgment as a matter of law, where it is quite clear what the truth is, that no genuine issue remains for trial, and that the purpose of the rule is not

to cut litigants off from their right of trial by jury if they really have issues to try" (emphasis added) (321 U. S. 627, 64 S. Ct. 728, 729).

In that case, defendant, in support of his Motion for Summary Judgment, had submitted opinion testimony of experts as to the value of gas leases. The sole affidavit by plaintiff disputing defendant's right to summary judgment was that of plaintiff's attorney indicating that each of defendant's experts had an interest or bias as to the subject matter of litigation. He did not submit expert testimony other than plaintiff's attorney's affidavit refuting that of the moving party's expert witnesses (in contrast to the instant suit). Nevertheless, this Court recognizing the importance of plaintiff's right to a trial where there is an issue as to the facts, reversed the Lower Court granting summary judgment.

That summary judgment is particularly questionable where there are conflicting affidavits of plaintiff and defendant is indicated in *Sarnoff et al.* v. *Ciaglia*, 3 Cir., 165 F. 2d 167 (1947).

Thus, the aforenoted *Associated Press* and *Sartor* cases indicate the *stringent requirements* for permitting adjudication by summary judgment and denying plaintiff's right to a trial on the merits. Even in the case where there was no direct expert testimony in behalf of plaintiff, this Court denied summary judgment to the defendant where they felt that issues of fact did exist (*Sartor* v. *Arkansas Natural Gas Corporation*, noted above).

Accordingly, the decision of the Circuit Court of Appeals granting summary judgment where the record shows that all of the testimony submitted by those "skilled in the art" to which the invention pertains indicated the validity of the patent in suit was not in accordance with the standards laid down by this Court.

Subsidiary to the foregoing is the question presented in this case with respect to overcoming the statutory presumption of validity attached to U. S. patents granted by the United States Patent Office (35 U. S. C. 282). More particularly, can the statutory presumption of validity of a United States patent be overcome without benefit of trial on the merits by a Motion for Summary Judgment where expert testimony has been submitted in support of the statutory presumption of validity, and where indeed all technical experts have attested to the non-obvious nature of the patented invention.

Settlement of these questions by this Court is plainly in the public interest.

CONCLUSION

For the foregoing reasons, this petition for a Writ of Certiorari should be granted.

Respectfully submitted.

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Date: March , 1964

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APPENDICES

APPENDIX A—Statutory Provisions

Art. 1, Sec. 8 of the United States Constitution—

> The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

Rule 56, Federal Rules of Civil Procedure—

> Rule 56. Summary Judgment
>
> (a) For Claimant. A party seeking to recover upon a claim, counterclaim, or cross-claim or to obtain a declaratory judgment may, at any time after the expiration of 20 days from the commencement of the action or after service of a motion for summary judgment by the adverse party, move with or without supporting affidavits for a summary judgment in his favor upon all or any part thereof. As amended Dec. 27, 1946, effective March 19, 1948.
>
> (b) For Defending Party. A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.
>
> (c) Motion and Proceedings Thereon. The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party

is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages. As amended Dec. 27, 1946, effective March 19, 1948.

(d) Case Not Fully Adjudicated on Motion. If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court at the hearing of the motion, by examining the pleadings and the evidence before it and by interrogating counsel, shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, including the extent to which the amount of damages or other relief is not in controversy, and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

(e) Form of Affidavits; Further Testimony. Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions or by further affidavits.

(f) When Affidavits are Unavailable. Should it appear from the affidavits of a party opposing the motion that he cannot for reasons stated present by affidavit

facts essential to justify his opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

(g) Affidavits Made in Bad Faith. Should it appear to the satisfaction of the court at any time that any of the affidavits presented pursuant to this rule are presented in bad faith or solely for the purpose of delay, the court shall forthwith order the party employing them to pay to the other party the amount of the reasonable expenses which the filing of the affidavits caused him to incur, including reasonable attorney's fees, and any offending party or attorney may be adjudged guilty of contempt.

Patent Act of 1952 (Title 35, United States Code)

Sec. 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Sec. 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

APPENDIX B

IN THE
UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 20505

RONEL CORPORATION,
Appellant,

versus

ANCHOR LOCK OF FLORIDA, INC., ET AL,
Appellees.

Appeal from the United States District Court for the Southern District of Florida.

(December 20, 1963.)

Before TUTTLE, Chief Judge, JONES, Circuit Judge, and JOHNSTON, District Judge.

TUTTLE, Chief Judge: This is an appeal from the partial summary final judgment of the district court which determined that the plaintiff's patent No. 2974368 in suit was invalid and consequently could not be infringed by the defendants.

Whatever disputes there are between the parties, one matter is plain: the patent in suit and the patent which the

trial court held anticipated it, No. 649761, known as the Saltzkorn patent, both describe very simple devices.

The Lidsky patent here in suit is entitled "Metal fastener." It consists of a metal plate with projecting barbs for securing members together. The Saltzkorn patent also consisted of metal projections extending from a metal plate, which projections were so designed as to be bendable for the purpose of also securing members together. The Saltzkorn patent was entitled "eyelet."

Upon the filing of a motion for summary judgment, the appellees submitted an affidavit of a patent attorney in support of their contention that the Saltzkorn patent anticipated the patent in suit. Appellant filed a cross motion for summary judgment, supported by several affidavits. Thus, says appellant, there were issues of fact as to which the trial court must conduct a full hearing rather than determine the issue by summary judgment.

While it is unusual for a court to dispose of a patent suit by summary judgment, such procedure is recognized as being appropriate in proper circumstances. We have stated as much in *Inglett & Co.* v. *Everglades Fertilizer Co., Inc.*, 255 F. 2d 342, 349. Although this Court did not, in that case, approve of the summary judgment there rendered, we cited as examples of proper cases for the use of summary judgment, *George P. Converse & Co., Inc.* v. *Polaroid Corp., et al.*, 1 Cir., 242 F. 2d 116, *Vermont Structural Slate Co.* v. *Tatko Bros. Slate Co.*, 2 Cir., 233 F. 2d 9, cert. den., 352 U. S. 917, and *Bobertz* v. *General Motors Corp.*, 6 Cir., 228 F. 2d 94.

We think the language of the *Tatko* case, *supra*, is apposite here:

> "Summary judgment represents a most useful legal invention to save time and expense, by the avoidance of a trial, when there exists no material fact-issues. It may well be that, in a patent case, a judge should

exercise unusual caution in granting a summary judgment. But there are patent cases where it would be an absurd waste of time and effort to deny such a judgment. This is such a case.

"In many a patent suit, there arise issues of fact as to which the testimony of expert witnesses may be important. Then the credibility of those witnesses is crucial, and it would be erroneous, by a summary judgment, to deprive either party of a 'live trial' at which the trial court could observe the witnesses' demeanor in evaluating their testimony. There was no such issue here. The prior art and the patent claims are, without expert aid, easily understandable by any one of the most modest intelligence. Nor did it require expert testimony to make it plain that the differences between the prior art and the patent claims were obvious to persons having ordinary skill in the trade at the time the alleged invention was made."

The trial court here stated: "The plaintiff's above cited patent construes merely an improvement and application of the principle and teaching of that certain patent issued to Emil Saltzkorn and Ludwig Nicolai on May 15, 1900, No. 649761, eyelet, to a new use which does not rise to the dignity of invention, but is in fact an application of the original Saltzkorn idea."

It is apparent to us that the trial court could, by observation of the two devices, readily arrive at the conclusion reached by it. The court could not be aided by the affidavits of any number of experts pro or con in reaching this conclusion. This, therefore, presented such a situation as was under consideration by the Court of Appeals for the Sixth Circuit in the *Roberts* case, *supra*, in which the Court said:

> "Where no factual issues are present and where the patents and products involved are sufficiently simple to make expert testimony unnecessary, disposition under rule 56 is proper."

We conclude that this was the unusual case in that it was a proper case for summary judgment.

The judgment of the trial court is, therefore,

AFFIRMED.

Partial Summary Final Judgment

Filed Sep. 28, 1961.

United States District Court Southern District of Florida, Miami Division.

RONEL CORPORATION, Plaintiff,

vs. No. 10,672-M-Civil.

ANCHOR LOCK OF FLORIDA, INC., GUSTAV L. VICTOR, S. HOWARD BANASZAK, HERMAN KOBRIN, CHESTER LEVINE, Defendants.

This matter having come on before the Court, upon the motions for summary judgment in the issue of validity and infringement of the plaintiff's Patent No. 2,974,378, entitled Metal Fastener, and the Court having considered said motions, the affidavit filed in support thereof, and the memoranda of counsel, and being fully informed in the premises, it is thereupon,

ORDERED AND ADJUDGED that partial summary final judgment be and the same is hereby entered in favor of the defendants and against the plaintiff, and pursuant thereto the Court does hereby find that the plaintiff's above cited patent construes merely an improvement and application of the principle and teachings of that certain patent issued to Emil Saltzkorn and Ludwig Nicholai on May 15, 1900, No. 64,761, Eyelet, to a new use which does not rise to the dignity of invention, but is in fact an application of the original Saltzkorn idea. It therefore follows and the

Court finds that the patent here in suit is invalid and consequently can not be infringed.

DONE AND ORDERED at Miami, Florida this 26th day of September, 1961.

EMMETT C. CHOATE,
United States District Judge.

Certificate of Service

It is hereby certified that a copy of the Petition for a Writ of Certiorari has been forwarded by first class mail, postage prepaid, to Schulze and Stansfield, Esqs., located at Pennsylvania Building, Washington, D. C. and to Ellis, Spencer and Butler, Esqs., located at 1909 Tyler Street, P. O. Box 6, Hollywood, Florida, attorneys for Respondent in this proceeding.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 929

RONEL CORPORATION, *Petitioner*,

v.

ANCHOR LOCK OF FLORIDA, INC., GUSTAV L. VICTOR, S. HOWARD BANASZAK, HERMAN KOBRIN, CHESTER LEVINE, *Respondents*.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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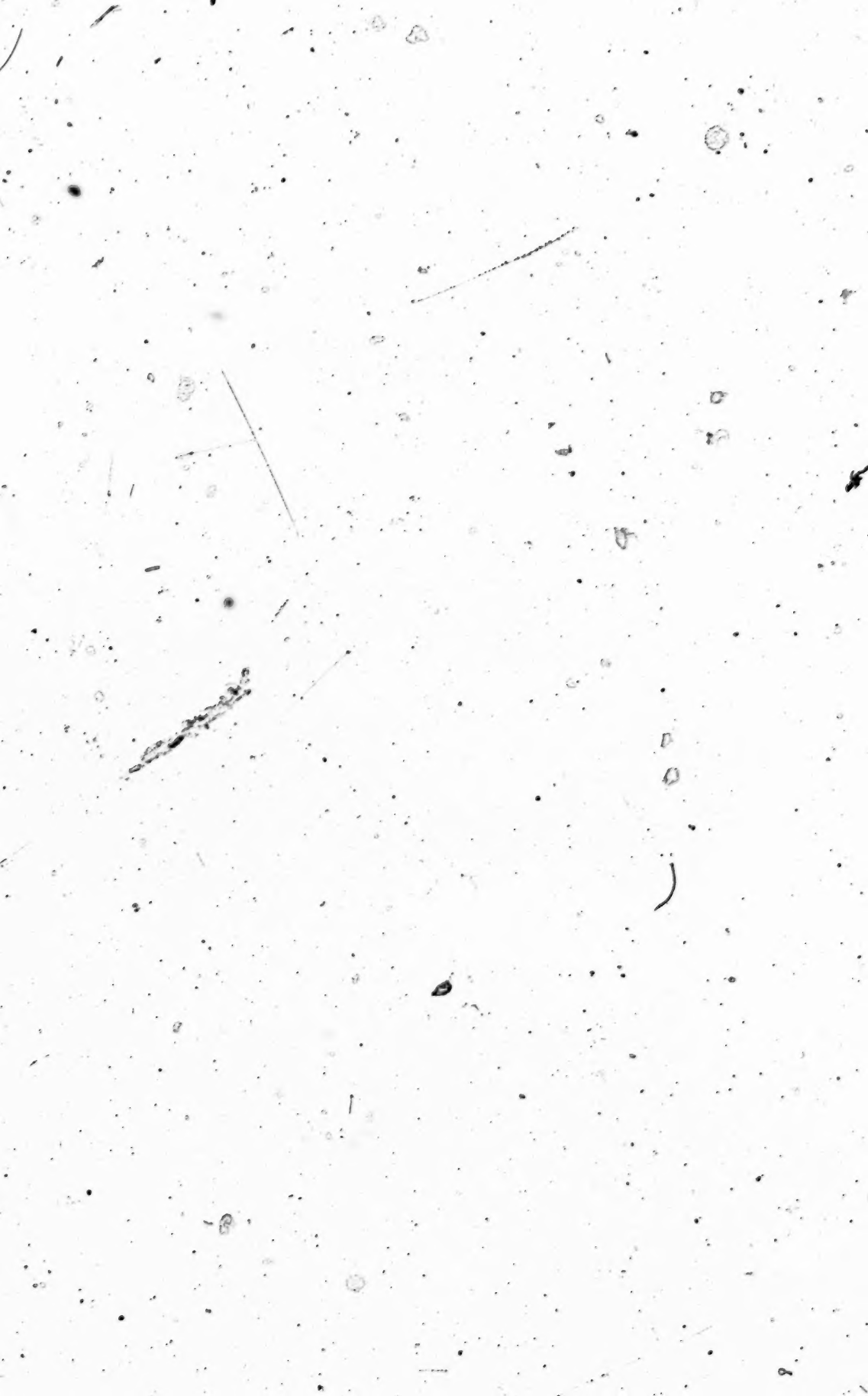

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IN THE

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CORRECT STATEMENT OF PROCEEDINGS BELOW

The decision of the United States Circuit Court of Appeals for the Fifth Circuit, December 20, 1963, 325 F. 2d 889, which Petitioner asks this Court to review, affirmed the Amended Partial Summary Final Judgment of the United States District Court, Southern District of Florida, February 25, 1963, appearing on pages 6 and 7 of the record of Appeal No. 20,505 and reproduced as Respondents' Appendix A hereto.

The decision of the United States Court of Appeals for the Fifth Circuit in Appeal No. 19,518 reported in 312 F. 2d 207 dismissed the appeal from Partial Summary Final Judgment of the United States District Court, Southern District of Florida, September 28, 1961, 198 F. Supp. 660, Petitioner's Appendix B, and is of no concern here.

QUESTIONS PRESENTED

Should this Court review partial summary judgment determining that a patent in suit is invalid where the patent claims and the prior art are so simple and readily understandable that expert testimony is unnecessary?

The Lidsky patent in suit is a simple mechanical patent with a single sheet of drawings and a single claim. The Lidsky patent and the prior art Saltzkorn et al. patent held to anticipate both are concerned with metal plates having projecting barbs for securing members together.

The crux of the decision of the Fifth Circuit Court of Appeals respecting this question is stated as follows:

> "It is apparent to us that the trial court could, by observation of the two devices, readily arrive at the conclusion reached by it. The court could not be aided by the affidavits of any number of experts pro or con in reaching this conclusion. This, therefore, presented such a situation as was under consideration by the Court of Appeals for the Sixth Circuit in the Bobertz case (i.e. *Bobertz v. General Motors*, 228 F. 2d 94) in which the Court said:
>
> > 'Where no factual issues are present and where the patents and products involved are

> sufficiently simple to make expert testimony unnecessary, disposition under Rule 56 is proper.' "

PETITIONER'S REASONS FOR SEEKING CERTIORARI ARE UNFOUNDED

Petitioner alleges four reasons in support of its request for certiorari none of which is applicable here. This is but an ordinary simple patent infringement case where the patent has been summarily invalidated upon ample precedent and there are no special and important reasons for review as required by Court Rule 19.

ARGUMENT

Cases like the instant case are not new to this Court. This Court denied certiorari, 352 U.S. 917, in another very similar simple patent case, *Vermont Structural Slate Co.* v. *Tatko Bros. Slate Co.*, 2 Cir., 233 F. 2d 9, from which the decision of the Fifth Circuit Court of Appeals in this case quotes as follows:

> "Summary judgment represents a most useful legal invention to save time and expense, by the avoidance of a trial, when there exists no material fact-issues. It may well be that, in a patent case, a judge should exercise unusual caution in granting a summary judgment. But there are patent cases where it would be an absurd waste of time and effort to deny such a judgment. This is such a case.
>
> "In many a patent suit, there arise issues of fact as to which the testimony of expert witnesses may be important. Then the credibility of those witnesses is crucial, and it would be erroneous, by a summary judgment, to deprive either party of a 'live trial' at which the trial court could observe

> the witnesses' demeanor in evaluating their testimony. There was no such issue here. *The prior art and the patent claims are, without expert aid, easily understandable by any one of the most modest intelligence. Nor did it require expert testimony to make it plain that the differences between the prior art and the patent claims were obvious to persons having ordinary skill in the trade at the time the alleged invention was made.*" (italics added)

This Court also denied certiorari, 361 U.S. 884, in *Glagovsky* v. *Bowcraft Trimming Co. et al.*, 4 Cir., 267 F. 2d 479, which affirmed summary judgment holding a patent invalid, stating:

> "The prior art and the patent claims are so simple that they can be readily understood by any normally intelligent person without the aid of expert testimony. There was, therefore, no error below in disposing of the plaintiff's suit on the motions for summary judgment and their supporting affidavits, depositions and exhibits."

The *Tatko* decision, *supra*, was cited with approval and the above italic language quoted in part by the First Circuit Court of Appeals in *George P. Congress & Co., Inc.* v. *Polaroid Corporation et al.*, 242 F. 2d 116, also affirming summary judgment holding a simple mechanical patent invalid over prior art.

The above italic language of *Tatko*, *supra*, was also quoted in full by the Court of Appeals for the District of Columbia Circuit in *Rothe* v. *Ford Motor Company*, 253 F. 2d 353, in affirming summary judgment holding a patent invalid.

The *Tatko* decision, *supra*, has also been cited with approval by other Circuit Courts of Appeals, among

them. *Rankin et al* v. *King et al.*, 9 Cir., 272 F. 2d 254; *Tatko Brothers Slate Co., Inc.* v. *Capitol Slate Co., Inc. et al.*, 3 Cir. (Feb. 17, 1964) 327 F. 2d 984, 140 USPQ 531, and *Fromberg, Inc.* v. *Gross Manufacturing Company, Inc.*, 9 Cir., (Feb. 26, 1964) F. 2d , 140 USPQ 641, all affirming summary judgment in patent cases.

CONCLUSION

Adequate reasons for review are lacking in this case.

This Court has established precedent, the *Tatko* and *Bowcraft* cases, *supra*, for denying certiorari in this case.

The Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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APPENDIX A

Amended Partial Summary Final Judgment

Filed Feb. 25, 1963.

United States District Court, Southern District of Florida, Miami Division.

No. 10,672-M-Civil

RONEL CORPORATION, *Plaintiff*,

v.

ANCHOR LOCK OF FLORIDA, INC., GUSTAV L. VICTOR, S. HOWARD BANASZAK, HERMAN KOFRIN AND CHESTER LEVINE, *Defendants*.

This matter having come on before the Court, upon the Motions for Summary Judgment in the issue of validity and infringement of the Plaintiff's Patent No. 2,973,378, entitled Metal Fastener, and the Court having considered said Motions, the Affidavit filed in support thereof, and the Memoranda of counsel, and being fully informed in the premises, it is thereupon,

Ordered and Adjudged:

That the Court expressly determines that there being no just reason for delay, the Court expressly directs that Partial Summary Final Judgment be and the same is hereby entered in favor of the Defendants and against the Plaintiff pursuant to Rule 54(b) of the Federal Rules of Civil Procedure, and pursuant thereto, the Court does hereby find that the Plaintiff's above-cited patent construes merely an improvement and application of the principle and teachings of that certain patent issued to Emil Saltzkorn and Ludwig Nicholai on May 15, 1900, No. 649,761, Eyelet, to a new use which does not rise to the dignity of invention, but is in fact an application of the original Salzkorn idea. It, therefore, follows and the Court finds that the patent here in suit is invalid and consequently cannot be infringed.

This Order amends and supersedes the Order previously entered on the 28th day of September, 1961.

Done and Ordered at Miami, Florida, this 18 day of February, 1963.

EMETT C. CHOATE,
United States District Judge.

Certificate of Service

It is hereby certified that copies of the foregoing Respondents' Brief in Opposition to Petition for Certiorari have been forwarded by first class mail postage prepaid to Henry L. Burkitt, 19 West 44th Street, New York, New York 10036 and Harold J. Kaplan, Robert L. Pearlman, Blum, Moscovitz, Friedman, Blum & Kaplan, 555 Madison Avenue, New York, New York 10022 and by air mail postage prepaid to Shapiro and Fried, Mercantile National Bank Building, 420 Lincoln Road, Miami Beach, Florida, attorney for Petitioner.

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Dated: April , 1964